



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant: Gregory M. Chrysler et al.
Title: FOLDED FIN HEAT SINKS

Docket No.: 884.148US1
Filed: August 18, 1999
Examiner: Leonard R Leo

Serial No.: 09/376,875
Due Date: June 20, 2005
Group Art Unit: 3753

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ A return postcard.
- ☒ Response to Restriction Requirement (4 Pages).

If not provided for in a separate paper filed herewith, Please consider this a **PETITION FOR EXTENSION OF TIME** for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Customer Number 21186

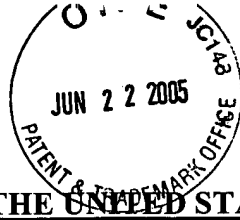
By: Ann M. McCrackin
Atty: Ann M. McCrackin
Reg. No. 42,858

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20th day of June, 2005.

John D. Gostin-Wrathell
Name

Ann M. McCrackin
Signature

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
(GENERAL)



S/N 09/376,875

PATENT

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RESPONSE TO RESTRICTION REQUIREMENT

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In response to the Restriction Requirement mailed April 20, 2005, Applicant hereby elects, with traverse, Species I (Fig. 2). At least claims 28-31 and 44-46 are readable on Species I. Claims 22-24, 27, 32 and 36-43 remain pending. If the determination that these claims, many of which have been pending since 2001 with the phrase "a clip," now represent a "patentably distinct species" is continued, claims 22-24, 27, 32 and 36-43 are hereby withdrawn. Upon allowance of a generic claim, however, Applicant is entitled to consideration of claims to additional species written in dependent form or which otherwise include all the limitations of an allowed generic claim as provided by 36 CFR 1.141. Applicant submits that at least claims 28-31 are generic.

Applicant notes that FIG. 8 depicts two clips (860₀ and 860₁), not "a clip" as suggested by the Restriction Requirement. See also specification, page 8, lines 13-14.

Additionally, in the Response to the original Restriction Requirement filed on August 18, 2000, Applicant elected the claims of Group I (Claims 1-12 and 22-24) and the Species of FIG. 2 (claims 1-3, 5-9 and 22-24). Applicant further noted in this Response that claims 4 and 10-12 remained pending in the application.

In response to an Office Action mailed on August 9, 2000, the pending claims were amended to recite "a clip" in the Amendment and Response filed on October 11, 2001. The subsequent Office Action mailed on June 4, 2002 presented arguments on the merits in response to these amendments based on Yeh (U.S. Patent No. 5,706,169), without raising an objection to the recitation of "a clip" in the claims. Claims reciting "a clip" remained in the Amendment and Response filed on December 4, 2002. The subsequent Office Action mailed on February 24,

2003 again presented arguments on the merits regarding use of “a clip” based on Yeh, again without raising an objection to the recitation of this element in the claims.

The Amendment and Response filed on April 24, 2003 was not entered as the proposed claims and amendments were found to raise new issues that would require further consideration and/or a search. The same Amendment and Response was entered together with an RCE filed on May 27, 2003. In this amendment, the phrase “at least two clips” was inadvertently returned to the claims. The subsequent Office Action noted this fact and withdrew the claims containing this phrase as being drawn to a nonelected species (i.e., claims 1-3, 5-9, 25-26 and 33-35). However, claims directed to “a clip” remained and arguments on the merits were again presented in the Office Action regarding use of “a clip.” For example, it was argued that the clip of Wyler (U.S. Patent No. 6,401,807) could be used to modify Jean (5,701,951) or Morosas (5,494,098). In another section of the Office Action, both Yeh and Wyler were cited in support of another argument relating to use of “a clip” in the prior art.

After two interviews with the Examiner seeking clarification of the need to withdraw claims directed to “at least two clips,” Applicant filed an Amendment and Response on August 25, 2003, in which claims reciting “a clip” were retained without objection. A Notice of Non-Compliant Amendment mailed on November 13, 2003 requested a listing of all claims readable on the elected species. Applicant noted in the Response to the Notice of Non-Compliant Amendment filed on December 15, 2003, that the claims readable on this elected species (i.e., FIG. 2) includes at least pending claims 22-24, 27-32 and 36-43 (claims 44-46 were not yet added). It is important to note that pending claims 22-24, 32 and 36-43 ALL continued to recite “a clip.” The subsequent Office Action mailed on December 9, 2004 yet again did not raise any issue regarding recitation of “a clip” in the claims and again presented arguments on the merits regarding use of “a clip.”

These same claims were presented in the Appeal Brief filed on August 9, 2004. The subsequent Office Action based on a new search and mailed on November 15, 2004 once again did not raise any issue regarding recitation of this element in the claims and actually withdrew all previous rejections based on Jean, Morosas, Lee and Yeh. However, this November 15, 2004

Office Action did raise, for the first time, an objection to the phrase "aspect ratio," a phrase understood in the art which had been present in the claims since April 24, 2003.

The Amendment and Response filed on January 18, 2005 retained the claims reciting "a clip." Now, for the first time, nearly four years after first being presented and after repeatedly being argued on its merits by both sides, is the phrase "a clip" being identified as a separate species in the Restriction Requirement mailed on April 20, 2005.

Applicant traverses this extraordinarily late identification of a separate species and requests that no additional objections to existing claim wording be generated. (See, for example, the recent objection to the phrase "aspect ratio" noted above, a phrase first presented over 1½ years prior to the objection. Applicant believes this objection has been overcome in the Amendment and Response filed on January 18, 2005). Applicant earnestly requests that this new determination of the presence of another patentably distinct species be withdrawn and a finding made on the merits that all pending claims are allowable.

The identification of another patentably distinct species is also traversed on the grounds that Restriction Requirements are optional in all cases. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it arguably may include claims to distinct or independent inventions MPEP 803. In the present application, since the claims in Species I are very closely related to the claims in Species II, it is respectfully submitted that the claims Species I and II can be (and were) efficiently and effectively searched in a single search with no additional burden placed on the Examiner. Indeed, such a search has not only has taken place once, but twice, and repeated examinations of both species have already been performed over the years.

The MPEP also states, in section 803, that not only must the inventions be independent, there must also be a serious burden on the Examiner. However, in this instance, as the Examiner has already performed searches which essentially cover both species, performed multiple examinations covering both species, thus providing arguments on the merits related to both species, it is clear that any burden on the Examiner is now moot as both "species" have already been examined-- repeatedly. Thus, there is no burden in continuing to prosecute all the pending claims in a single application.

RESPONSE TO RESTRICTION REQUIREMENT

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The Restriction Requirement mailed on April 20, 2005 incorrectly indicated that the period for reply was three (3) months from the mailing date rather than one (1) month. During a conversation with Anne Richards, a paralegal with Schwegman, Lundberg, Woessner & Kluth, P.A., on May 26, 2005, the Examiner agreed to move the period for reply to two (2) months from the mailing date, i.e., June 20, 2005. The Applicant thanks the Examiner for this courtesy.

All of the pending claims are in condition for allowance and notification to that effect is earnestly requested. Applicant urges the Examiner to telephone Applicant's attorney, Barbara Clark at (515) 233-3865, or the below signed attorney to discuss any remaining issues in order to bring this lengthy prosecution to a close. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

GREGORY M. CHRYSLER ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
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Date June 20, 2005

By Ann M. McCrackin
Ann M McCrackin
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 20th day of June, 2005.

Name

John D. Bruster - Wrathell

Signature

John D. Bruster - Wrathell